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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/515,060 02/28/00 JOAO

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EXAMINER

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ART UNIT

PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/515,060

Filing Date: February 28, 2000

Appellant(s): Raymond A. Joao

Raymond A. Joao
For Appellant

MAILED
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Technology Center 2100

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 13, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

Art Unit: 2153

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 4-7, 9, 11-19 and 21-26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,721,829

DUNN et al

2-1998

Houstis et al., "Internet, Education, and the Web," Proceedings of WET ICE (1996). *pgs 27-32*

Dwyer et al., "Creating a Virtual Classroom for Interactive Education on the Web *pgs 1-9*"

(December 1995). *WWW '95*

Art Unit: 2153

Goldberg, "World Wide Web - Course Tool: An Environment for Building WWW Based Courses," Fifth International World Wide Web Conference (May 1996). *Pg 1-16*

Hamalainen et al., "Electronic Markets for Learning: Educational Brokerages on the Internet," Communications of the ACM (June 1996). *Pg 1-9*

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-7, 9, 11, 16-19 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis (*Internet, Education, and the Web*) in view of Dunn et al (US 5,721,829). This rejection is set forth in prior Office Action, Paper No. 6.

Claim 12 is rejected under 35 U.S.C. 103 as being unpatentable over Houstis (*Internet, Education, and the Web*) in view of Dunn et al (US 5,721,829) and further in view of Dwyer et al (*Creating a Virtual Classroom for Interactive Education on the Web*). This rejection is set forth in prior Office Action, Paper No. 6.

Claims 13, 14, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis (*Internet, Education, and the Web*) in view of Dunn et al (US 5,721,829) and further in view of Goldberg (*World Wide Web - Course Tool: An Environment for Building WWW Based Courses*). This rejection is set forth in prior Office Action, Paper No. 6.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis (*Internet, Education, and the Web*) in view of Dunn et al (US 5,721,829) and further in view of Hamalainen

Art Unit: 2153

et al (*Electronic Markets for Learning: Educational Brokerages on the Internet*). This rejection is set forth in prior Office Action, Paper No. 6.

(11) Response to Arguments

(A) Independent claims 1, 16, 18 and 25

The arguments set forth by Appellant concerning each independent claim are essentially the same and thus the Examiner will respond to the arguments regarding the independent claims as a group in an effort to avoid duplication of arguments. Appellant's main argument focuses on the assertion that the Examiner utilized impermissible hindsight regarding the combination of Houstis and Dunn. Specifically, the Appellant asserts (see page 23, for example):

“Applicant respectfully submits that the Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claim 1. Applicant submits that the Examiner’s reasoning in support of his rejection of independent Claim 1 serves to further support Applicant’s position that the Examiner engaged in the use of hindsight in reaching the asserted obviousness determination regarding independent Claim 1.”

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure,

Art Unit: 2153

such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Permissible hindsight is based on the finding that knowledge contained in an applicant's disclosure was also available from the prior art (i.e., it was available independently from the disclosure) at the time of the applicant's invention. Impermissible hindsight, in contrast, is based on knowledge imparted only from an applicant's disclosure. It is the Examiner's position that the combination of Houstis and Dunn is based on permissible hindsight only.

The instant application is directed to a distance learning system where students can request to view educational material on demand (e.g., video lecture). This enables a student to view the material as his schedule permits. When a student terminates the transmission of educational material, the system marks the location in the material where the student has stopped. At a point later in time, when the student wishes to resume viewing the educational material, the system resumes transmission of the previous material by retransmitting a portion of the material already viewed. This retransmission of a portion of the material enables the student to refresh his/her memory regarding where in the educational material the student had ended the transmission.

The rejection formulated by the Examiner combines the teachings of Houstis and Dunn to arrive at the claimed invention. Houstis provides a distance learning system where students can request to view educational material on demand (e.g., video lecture). Houstis does not provide the ability for a student to terminate transmission of the educational material and resume by retransmitting a portion of the material. Dunn, however, discloses a video on demand system

Art Unit: 2153

which allows a user to order entertainment type material over a network. A user is able to choose a particular program to view by ordering the program through a central processor. After the transmission of the program has begun, if the user stops viewing the program, the system marks a point in the program where the user stopped viewing. When the user returns to the channel to resume viewing the program, the system retrieves the unfinished program and is able to roll a portion of the program back to refresh the viewer's memory (column 7, line 34 - column 8, line 11). Specifically, the reference notes (see column 7, line 65 - column 8, line 3):

“The video content playing unit employs the viewer ID and pause point to access the CMS database and retrieve the unfinished program (step 232). At step 234, the program can be optionally rolled back so that a portion of the program is repeated to refresh the viewer with the sequence of events where the viewer last left off.”
(Emphasis added.)

Appellant repeatedly states that the Examiner has failed to point to any teaching, motivation, or suggestion, for combining Dunn with Houstis. However, as shown in the above passage, Dunn clearly discloses the advantage of rolling back a portion of material that was previously transmitted to a user in order to refresh the user's memory as to where the user last left off. One of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material.

Applicant appears to be insinuating that because Dunn discloses the same advantage to rolling back a portion of a transmitted material as does the Appellant, that the Examiner should

Art Unit: 2153

not be allowed to introduce such a reference due to hindsight reasoning. This argument is not persuasive. The Examiner's position is that the advantage was known in the prior art independently from Appellant's disclosure. This is a clear example of permissible hindsight. As stated previously, permissible hindsight is based on the finding that knowledge contained in an applicant's disclosure was also available from the prior art (i.e., it was available independently from the disclosure) at the time of the applicant's invention.

Appellant further asserts (see page 26, for example):

"Applicant submits that the Examiner improperly looked beyond the teachings of Houstis and Dunn and, therefore, utilized hindsight by attempting to classify the Applicant's general field of endeavor as being concerned with transmitting multimedia data on demand to remote users. See Office Action, dated March 28, 2001, page 9, lines 1-3..."

Applicant respectfully submits that the Examiner's reasoning evidences the fact that the Examiner improperly looked beyond the teachings of Houstis and Dunn by providing his own hindsight-based nexus for combining the two references only after using Claim 1 as a blueprint."

Appellant appears to be confusing the issue of "analogous art" with the issue of "motivation to combine references." The statements concerning the "field of endeavor" made by the Examiner in the Office Action dated March 28, 2001, were concerned with establishing the position that Dunn was, in fact, analogous art. To qualify as prior art under 35 U.S.C. 103, art must be analogous. Analogous art is art in the field of the applicant's endeavor or art reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Art Unit: 2153

Once it has been determined that certain prior art could have been combined because it is analogous art, it must then be shown that there was a suggestion, i.e., a motivation for the proposed combination. The prior art as a whole must have contained something to suggest the "desirability," and thus the obviousness, of making the combination. As explained above, Dunn clearly discloses the desirability of rolling back a portion of material that was previously transmitted to a user in order to refresh the user's memory as to where the user last left off.

Appellant further asserts (see page 27, for example):

"Applicant respectfully submits that the Examiner's statements, in support for his combining of the teaching of Houstis and Dunn, lacked the clarity and particularity which is required by controlling case law. Applicant further submits that the Examiner's statements in support for combining Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper."

Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and particular as required by governing case law. Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 2153

(B) Dependent claims 2, 4-7, 9, 11-15, 17, 19, 21-24 and 26

Appellant does not provide separate arguments for dependent claims 2, 4-7, 9, 11, 17, 19, 21, 24 and 26, other than stating that the combination of Houstis in view of Dunn does not disclose or suggest the invention as recited in each of the claims. The Examiner maintains the position set forth in the prior Office Action, Paper No. 6, and thus will not present individual responses for each claim.

Appellant does not provide separate arguments for dependent claim 12, other than stating that the combination of Houstis in view of Dunn and further in view of Dwyer does not disclose or suggest the invention as recited in each of the claims. The Examiner maintains the position set forth in the prior Office Action, Paper No. 6, and thus will not present individual responses for each claim.

Appellant does not provide separate arguments for dependent claims 13, 14, 22 and 23, other than stating that the combination of Houstis in view of Dunn and further in view of Goldberg does not disclose or suggest the invention as recited in each of the claims. The Examiner maintains the position set forth in the prior Office Action, Paper No. 6, and thus will not present individual responses for each claim.

Appellant does not provide separate arguments for dependent claim 15, other than stating that the combination of Houstis in view of Dunn and further in view of Hamalainen does not disclose or suggest the invention as recited in each of the claims. The Examiner maintains the

Application/Control Number: 09/515,060

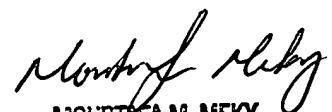
Page 10

Art Unit: 2153

position set forth in the prior Office Action, Paper No. 6, and thus will not present individual responses for each claim.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully Submitted,



MOUSTAFA M. MEKY
PRIMARY EXAMINER

kwf
October 29, 2001

Conferees: Kenneth Fields *KF*
Glenton Burgess *GS*
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